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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,742	04/07/2000	Alex Kuperman	44251	2331

109 7590 02/11/2003

THE DOW CHEMICAL COMPANY  
INTELLECTUAL PROPERTY SECTION  
P. O. BOX 1967  
MIDLAND, MI 48641-1967

EXAMINER
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JOHNSON, EDWARD M

ART UNIT	PAPER NUMBER
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1754

DATE MAILED: 02/11/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/544,742	KUPERMAN ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Edward M. Johnson	1754

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 January 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

a)  The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
 ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1.  A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2.  The proposed amendment(s) will not be entered because:
  - (a)  they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b)  they raise the issue of new matter (see Note below);
  - (c)  they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d)  they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5.  The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6.  The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7.  For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 15, 17 and 20.

Claim(s) rejected: 1-14, 16, 18, 19 and 21-32.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8.  The proposed drawing correction filed on \_\_\_\_\_ is a) approved or b) disapproved by the Examiner.
9.  Note the attached Information Disclosure Statement(s)( PTO-1449) Paper No(s). \_\_\_\_\_.
10.  Other: \_\_\_\_\_

Continuation of 2. NOTE: The proposed amendment would add the recitation "for use in an oxidation process in the presence of hydrogen" to claim 1 and "characterized by the presence of a titanium-carbon sigma or pi bond" to claim 11, both of which are new issues requiring further search and/or consideration.

Continuation of 5. does NOT place the application in condition for allowance because: It is argued that the Examiner argues that the references meet the standards of *In re Oetiker*. This is not persuasive because the amendment which Applicant relies upon has not yet been entered. It is noted that the features upon which applicant relies (i.e., a catalyst "limited to a particular use") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is argued that *Iwakura* very clearly pertains to an impregnation process. This is not persuasive because Applicants' field of endeavor is unchanged (see above) and because Applicant appears to suggest that the disclosure of the prior art is among a "laundry list" while Applicant nevertheless himself claims various combinations of metals with gold that could similarly be characterized as a laundry list (see instant dependent claims). It is argued that case law further establishes that... to combine the references. This is not persuasive because the Examiner has not taken the position that the claims are "obvious to try" as Applicant appears to suggest. The Examiner's motivational statement has already been made of record. It is argued that while the arguments below have been presented before... should that be necessary. Since the amendment has not yet been entered, the Examiner refers to the corresponding responses made in the Final Rejection to the identical arguments copied in Applicant's remarks. It is argued that the Final Rejection in its generality... to the prior art. This is not persuasive because Applicant does not appear to argue or suggest that one of ordinary skill would limit himself to prior art only having identical metals. Instead Applicant merely appears to admit that the instant invention would also be obvious to try, which is not an issue. The Examiner has not taken the position that the instant claims would be obvious to try. The Examiner's motivational statement is made of record in the Final Rejection. It is argued that the Final Rejection maintains that it is not persuasive... at titanium catalyst. This is not persuasive for reasons already made of record. The cited limitations are disclosed for use not only in any catalyst, but specifically a titanium catalyst.



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